

### **REMARKS/ARGUMENTS**

The office action of December 19, 2003 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1-36 remain in this application and new claim 37 has been added.

Preliminarily, applicants note with appreciation the indication that the application contains allowable subject matter. Specifically, claim 9 stands objected to for being dependent upon a rejected base claim, but would be allowable if amended to incorporate all the features of its ultimate base claim.

Applicants have submitted numerous Information Disclosure Statements (IDS) during prosecution of the instant application. While most of the IDS' and PTO-1449 forms have been fully initialed by the Examiner noting consideration of the cited references, Applicants raise the following remaining issues:

1. The electronic IDS submitted November 26, 2003 has not been made of record or, alternatively, the undersigned did not receive an initialed copy of the submission indicating the Examiner's consideration of the references submitted. A copy of the IDS is submitted herewith, along with an acknowledgement receipt received from the USPTO. Applicants respectfully request that the Examiner forward with the next communication an initialed copy of the electronic IDS to make the art cited therein of record.

2. The undersigned did not receive the initialed copy of the second page of the PTO-1449 form submitted with the IDS filed on November 27, 2002. In addition, three of the references identified on page 1 of the PTO-1449 form have been crossed-through. The undersigned is confused as to why these references have been crossed-through. A copy of page 2 is attached, along with a copy of page 1 showing the reference citations crossed-through by the Examiner. Applicants respectfully request that the Examiner either confirm that these crossed-through references be made of record, or alternatively that the Examiner return an initialed PTO-892 make these references of record.

3. The undersigned did receive the initialed copy of the PTO-1449 form (4 pages) submitted with the IDS filed on June 23, 2003; however, on page 1, five of the cited references have been crossed-through. Again, the undersigned is confused as to why these references have been crossed-through. A copy of page 1 showing the reference citations crossed-through by the Examiner is attached. Applicants respectfully request that the Examiner either confirm that these crossed-through references be made of record, or alternatively that the Examiner return an initialed PTO-892 make these references of record.

Claims 7, 16, 17, 30-35 have been amended to correct an antecedent basis problem discovered by the undersigned. Also, claim 19 has been amended to remove duplicative claim language. Claim 11 has been amended to add punctuation and a conjunction.

Claim 6 has been objected to for a minor informality, which has been attended to by amending the claim to depend from claim 5.

Claims 1-5, 8, 11-16 and 21-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 6,647,534 to *Graham* and claims 6, 7, 10 and 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Graham* as applied to claim 1, and further in view of U.S. patent no. 6,122,649 to *Kanerva*. Applicants respectfully traverse these rejections.

**Graham Does Not Qualify as Prior Art**

Applicants are submitting herewith a Declaration under 37 C.F.R. § 1.131 to establish a date of invention prior to the effective date of *Graham* as a reference. Specifically, applicants reduced their invention to practice prior to *Graham*'s filing date of June 30, 1999. Accordingly, withdrawal of all the rejections based on *Graham* is respectfully requested.

**Kanerva and the Instant Application are Commonly Owned – Claims 6, 7, 10, and 17-20**

The *Kanerva* patent only qualifies as prior art to the instant application under 35 U.S.C. § 102(e). The instant application and *Kanerva* were, at the time of the instant invention was made, owned by, or subject to an obligation of assignment to Microsoft Corporation. Therefore, pursuant to 35 U.S.C. § 103(c), *Kanerva* cannot be used alone or in combination to reject the claims of the instant application pursuant to 35 U.S.C. § 103. For this additional reason,

applicants respectfully request withdrawal of the rejection of claims 6, 7, 10, and 17-20. Also, claims 16, 21-29, 34 and 35 cannot be rejected over a combination including *Kanerva*.

**Claims 21-29, 34 and 35**

Applicants submit that the rejection of claims 21-29, 34 and 35, each of which ultimately depends from independent claim 20, based on *Graham* alone is improper. More particularly, the action has already admitted that *Graham* does not render obvious claim 20. Thus, pursuant to 35 U.S.C. § 112, ¶4, *Graham* alone cannot render obvious claims 21-29, 34 and 35. Also, irrespective of whether the combination of *Graham* and *Kanerva* results in the invention of claims 21-29, 34 and 35, *Kanerva*, as discussed above, cannot be used to reject the claims of the instant application pursuant to 35 U.S.C. § 103. For at least these reasons, claims 21-29, 34 and 35 are considered allowable.

**Claim 16**

The action alleges that claim 16 is rejected for the same reasons as claims 1-5. Yet claim 16 includes the same features (in addition to claim 11) as claim 6 (in addition to claim 1), and the action acknowledged that claim 6 was not anticipated by *Graham*. Instead, claim 6 was rejected over the combination of *Graham* and *Kanerva*. Irrespective of whether the combination of *Graham* and *Kanerva* results in the invention of claim 16, *Kanerva*, as discussed above, cannot be used to reject the claims of the instant application pursuant to 35 U.S.C. § 103.

**Claims 30-33 and 36**

The action has failed to identify a teaching or suggestion in *Graham* of displaying an index having at least one link and a corresponding context associated with a selected one of the at least one link as recited in claims 30-33. Nor has the action identified a teaching or suggestion in *Graham* of a method of displaying multiple contexts of electronic documents, the method including successively displaying a plurality of document contexts to create a unified navigational history; and displaying two of the document contexts simultaneously without changing the unified navigational history as recited in independent claim 36.

**New Claim**

New claim 37 is fully supported by the specification and considered allowable over the art of record.

Appln. No.: 09/556,865  
Amendment dated April 15, 2004  
Reply to Office Action of December 19, 2003

### CONCLUSION

A Fee Transmittal is attached. If any additional fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

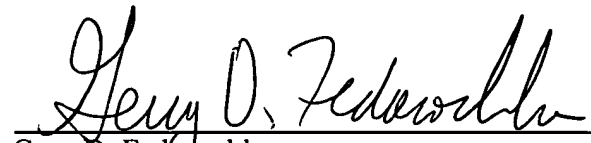
All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: April 15, 2004

By:

  
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**UNITED STATES PATENT AND TRADEMARK OFFICE  
ACKNOWLEDGEMENT RECEIPT**

Electronic Version 1.1

Stylesheet Version v1.1.1

Title of Invention

Method and Apparatus for Displaying Multiple Contexts in Electronic Documents

Submission Type: Information Disclosure Statement

Application Number: 09/556865

\*09/556865\*

EFS ID: 51328

Server Response:

Confirmation Code	Message
ISVR1	Submission was successfully submitted - Even if Informational or Warning Messages appear below, please do not resubmit this application
ICON1	6686
ISYS5	Filename= N/A BusinessRule= Validation System/Function Call Information. #Supporting Msg:Server unable to validate the Confirmaton/Application numbers at this time. They will be checked by PTO personnel later.

First Named Applicant: Darryl Rubin

Attorney Docket Number: 003797.80028

Timestamp: 2003-11-26 11:48:53 EDT

From: us

File Listing:

Doc. Name	File Name	Size (Bytes)
us-ids	379780028eIDS112603-usidst.xml	5383
us-ids	us-ids.dtd	7763
us-ids	us-ids.xsl	12026
package-data	379780028eIDS112603-pkda.xml	1878
package-data	package-data.dtd	27025
package-data	us-package-data.xsl	19263
Total files size		73338

Message Digest: c8937a56827e9949977a57099aec5ea30addbc43

Digital Certificate Holder Name: cn=Gary D. Fedorochko,ou=Registered Attorneys,ou=Patent and Trademark Office,ou=Department of Commerce,o=U.S. Government,c=US

# ELECTRONIC INFORMATION DISCLOSURE STATEMENT

Electronic Version v18

Stylesheet Version v18.0

## Title of Invention

## Method and Apparatus for Displaying Multiple Contexts in Electronic Documents

Application Number: 09/556865

\*09/556865\*

Confirmation Number: 6686

First Named Applicant: Darryl Rubin

Attorney Docket Number: 003797.80028

Art Unit: 2178

Examiner: M Ludwig

Search string: ( 5680636 or 5727129 or 5838914 or 5893132 or 6049812 or 6195694 or 6199082 or 6486895 or 6549220 or RE34476 or 5471568 or 5719595 or 5940080 ).pn.

**Certification:** This Information Disclosure Statement was submitted under the following conditions, which satisfies the requirement under 37 CFR 1.97(e). The filer certified:

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement.

## US Patent Documents

Note: Applicant is not required to submit a paper copy of cited US Patent Documents

init	Cite.No.	Patent No.	Date	Patentee	Kind	Class	Subclass
	1	5680636	1997-10-21	Levine et al.			
	2	5727129	1998-03-10	Barrett et al.			
	3	5838914	1998-11-17	Carleton et al.			
	4	5893132	1999-04-06	Huffman et al.			
	5	6049812	2000-04-11	Bertram et al.			
	6	6195694	2001-02-27	Chen et al.			
	7	6199082	2001-03-06	Ferrel et al.			
	8	6486895	2002-11-26	Robertson et al.			
	9	6549220	2003-04-15	Hsu et al.			
	10	RE34476	1993-12-14	Norwood			

	11	5471568	1995-11-28	Webb et al.
	12	5719595	1998-02-17	Hoddie et al.
	13	5940080	1999-08-17	Ruehle et al.

## Remarks

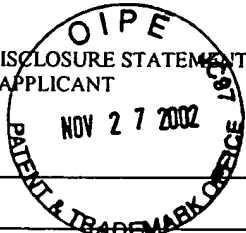
Note: Remarks are not for responding to an office action.

In accordance with Applicants' duty of disclosure, the following information is submitted for consideration by the United States Patent and Trademark Office in connection with the above-captioned application. The information is identified on the attached PTO 1449 form. Applicants do not waive any right to take appropriate action to establish patentability over the listed documents should they be applied as references against the claims of the present application. It is respectfully requested that the Examiner fully consider each of the documents, initial the enclosed Form PTO-1449 in the appropriate place to indicate that the document has been considered, and return a copy of the initialed form to the undersigned in accordance with MPEP Section 609. The undersigned certifies under 37 CFR 1.97(e)(2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. The references contained in this information disclosure statement were cited by the Examiner in a related application. Applicants believe that no fee is necessary pursuant to 37 CFR 1.97(b). However, if a fee is due, the Office is authorized to charge Deposit Account No. 19-0733.

## Signature

Examiner Name	Date

PTO-1449 (Modified)  U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  INFORMATION DISCLOSURE STATEMENT BY APPLICANT	ATTY. DOCKET NO. 003797.80028	SERIAL NUMBER 09/556,865
	APPLICANT Darryl Rubin et al.	
	FILING DATE 04/21/00	GROUP ART UNIT 2776



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## U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE
MS	6,034,689	03/07/00	White et al.			
MS	6,018,344	01/25/00	Harada et al.			
MS	6,397,264	05/28/02	Stasnick et al.			
MS	6,243,091	06/05/01	Beratis			
MS	5,854,630	12/29/98	Nielsen			
MS	5,835,092	11/10/98	Boudreau et al.			
MS	6,072,400	06/06/00	Bates et al.			

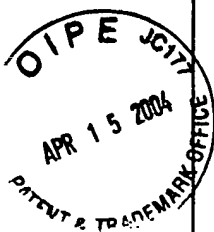
## FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	TRANSLATION: YES/NO

## OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)


EXAMINER	<i>Matthew Luby</i>	DATE CONSIDERED	<i>12/10/03</i>
EXAMINER: Initial citation if reference was considered. Draw line through citation if not in conformance to MPEP 609 and not considered. Include copy of this form with next communication to applicant.			





PTO-1449 (Modified)  U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE  INFORMATION DISCLOSURE STATEMENT BY APPLICANT	ATTY. DOCKET NO. 003797.80028	SERIAL NUMBER 09/556,865
	APPLICANT Darryl Rubin et al.	
	FILING DATE 04/21/00	GROUP ART UNIT 2776

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE
	5,717,860	02/10/98	Graber et al.			
	6,377,983	04/23/02	Cohen et al.			
	6,105,044	08/15/00	DeRose et al.			
	5,860,074	01/12/99	Rowe et al.			
	5,819,301	10/06/98	Rowe et al.			
	6,243,071	06/05/01	Shwartz et al.			
	6,037,934	03/14/00	Himmel et al.			

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	TRANSLATION YES/NO	

## OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)


EXAMINER	DATE CONSIDERED
EXAMINER: Initial citation if reference was considered. Draw line through citation if not in conformance to MPEP 609 and not considered. Include copy of this form with next communication to applicant.	

Substitute for form 1449A/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Sheet

1

of

4

**Complete if Known**

Application Number	09/556,865
Filing Date	04/21/2000
First Named Inventor	Darryl Rubin et al.
Group Art Unit	2776
Examiner Name	TBD
Attorney Docket Number	003797.80028

**RECEIVED**  
JUN 24 2003  
Technology Center 2100**U.S. PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number - Kind Code <sup>2</sup> (if known)			
MT		US- 5,239,466	08/24/1993	Morgan et al.	
MT		US- 5,434,965	07/18/1995	Matheny et al.	
MT		US- 5,572,643	11/05/1996	Judson	
MT		US- 5,632,022	05/20/1997	Warren et al.	
MT		US- 5,682,439	10/28/1997	Beermink et al.	
MT		US- 5,687,331	11/11/1997	Voik et al.	
MT		US 5,877,757	03/02/1999	Baldwin et al.	
MT		US 5,978,818	11/02/1999	Lin	
MT		US 6,321,244 B1	11/20/2001	Liu et al.	
MT		US- 5,717,879	02/10/1998	Moran et al.	
MT		US- 5,729,687	03/17/1998	Rothrock et al.	
MT		US- 6,181,344	01/30/01	Terpenning et al.	
MT		US- 6,094,197	07/25/00	Buxton et al.	
MT		US- 5,745,116	04/28/1998	Pisutha-Arnold	
MT		US- 6,331,867	12/18/2001	Eberhard et al.	
MT		US- 6,356,287	03/12/2002	Ruberry et al.	
MT		US- 5,790,818	08/04/1998	Martin	
MT		US- 5,821,925	10/13/1998	Carey et al.	
MT		US- 5,948,040	09/07/1999	DeLorme et al.	
MT		US- 5,950,214	09/07/1999	Rivette et al.	
MT		US- 6,389,494 B1	05/14/2002	Rivette et al.	

**FOREIGN PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>3</sup>
		Country Code <sup>3</sup> - Number <sup>4</sup> - Kind Code <sup>5</sup> (if known)				
MT		WO 96/20908	07/11/1996	Mikitenko et al.		
MT		WO 98/06054	02/12/1998	Huffman et al.		
MT		WO 99/49383	09/30/1999	Ruberry et al.		

Examiner  
Signature

Matthew Ludy

Date  
Considered

12/10/03

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.